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Remarks

Claims 47-51, 53, 54, 56-58, 60, 62-64, 66 and 68 are pending in the application. Claims 47, 57, and 63 have been amended. No new matter has been added by the amendments. Reconsideration is respectfully requested.

Improper Final Rejection

Applicants submit that this Office action was improperly designated a final Office action. According to MPEP section 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." Applicants submit that, here, the Office action introduced the new rejection of statutory double patenting based on U.S. Patent No. 5,779,486 (hereinafter "the '486 patent"). This rejection was not necessitated by Applicants' amendments to the claims. The amendments to claims 47, 57 and 63 in Applicants' prior response adding the language "from a group of rules" and "that is added to the group of rules" did not necessitate the new ground of rejection as these were merely clarifying amendments that would not have affected whether the double patenting issue raised now as pertaining to claims 7 and 12 of the '486 patent could have been raised previously.

Further, the '486 patent was not submitted in an information disclosure statement filed during the period set for in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Accordingly, Applicants respectfully request that the finality of this Rejection be withdrawn.

Objection to the Drawings

In the Office action, Fig. 9 was objected to for incorporating new matter. Specifically, the Office action objected to the addition of structure with the

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statement, "computer with storage." This objection is respectfully traversed.

In the Office action response of October 12, 2010, reference was made to sections of the specification which provide support for Fig. 9. For example, reference was made to the following recitation of Applicants' specification at paragraph [0049] which recites, "Figure 1 shows one embodiment of the invention including a super-recommendation generator 100 for implementing a computer-aided learning method to help a student or a user learn a subject. The generator 100 in general is for enhancing the learning experience of the user, and can be implemented in software, firmware, hardware or some combination of the above."

As described in Applicants' specification, the super-recommendation generator includes, for example, an inference engine. Applicants' specification at paragraph [0015].

As to the inference engine, Applicants' specification, for example, provides:

The inference engine accesses a set of relationship rules that define relationship among the line items and the subject. Then applying the set of relationship rules to the user's test results, the inference engine determines the user's level of understanding in the subject to provide recommendations for the user. Applicants' specification, paragraph [0016].

Applicants' specification also, for example, provides:

If there is any conflict among one or more relationship rules with the contents in the test results, or if there is any conflict among two or more relationship rules, the inference engine can resolve it. Resolving such conflicts help to ensure a consistent assessment of the user's understanding in the subject. Applicants' specification, paragraph [0017].

Further, Applicants' specification, for example, provides:

In one embodiment, a system implements an embodiment of the present invention preferably in software and hardware. The system includes a server computer and a number of client computers. Each client computer communicates to the server computer through a dedicated communication link, or a computer network.

The client computer typically includes a bus connecting a number of components, such as a processing unit, a main memory, an I/O controller, a peripheral controller, a graphics adapter and a network interface adapter. The

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I/O controller is connected to components, such as a harddisk drive. The peripheral controller is connected to components, such as a keyboard. The graphics adapter is connected to a monitor; and the network interface adapter is connected to the network. The network includes the internet, an intranet, the world wide web and other forms of networks. Different components of the present invention can be in different elements. Applicants' specification, paragraphs [0064.01-0064.02].

Thus, it is seen that at least one embodiment of Applicants' specification provides support for a super-recommendation generator that includes, for example, an inference engine which, at least in one embodiment, performs steps recited in Fig. 9. The super-recommendation generator can be implemented, for example, in software, firmware, hardware or some combination thereof, which, for example, includes a computer including storage. It follows that support is found for Fig. 9 in Applicants' specification. Accordingly, withdrawal of the objection to Fig. 9 is respectfully requested.

Specification Objection

In the Office action, the Examiner requests that the second occurrence of "[0048]" on page 13 should be deleted. Applicants submit that the second occurrence has been deleted. Accordingly, the objection should be withdrawn.

Statutory Double Patenting Rejection

Claims 47, 57 and 63 were rejected under 35 USC § 101 for claiming the same invention as that of claims 7 and 12 of prior U.S. Patent No. 5,779,486 (hereinafter, "the '486 patent"). This rejection is respectfully traversed.

A test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438 (CCPA 1970). Here, claims 47, 57 and 63 of the present patent application could be literally infringed without literally infringing claims 7 and 12 of the '486 patent.

Claim 7 of the '486 patent depends from independent claim 1, and claim 12 of the '486 patent depends from claim 7. Claim 1 of the '486 patent recites, inter alia, a system comprising "a score generator for accessing the student's

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prior-to-the-latest test results and the latest test results; and a recommendation generator coupled to the score generator for...analyzing the student's prior-to-the latest and the latest test results using the set of rules to generate a recommendation which provides an assessment on the student's understanding in the subject."

In contrast, claims 47, 57 and 63 recite, inter alia, determining "whether the at least two rules have a conflict in view of an assessment of the user...." The specification, for example, provides in one embodiment, "the invented method and system are based on the latest test results from the latest test taken by the user on the subject...." Applicants' specification, page 3, paragraph [0012].

Thus, at least as shown in this example, Applicants' claims 47, 57 and 63 could be literally infringed without literally infringing claim 1 of the '486 patent, because an assessment in the pending claims 47, 57 and 63 is not limited to "analyzing the student's prior-to-the latest and the latest test results using the set of rules to generate a recommendation which provides an assessment...." With claims 7 and 12 of the '486 patent incorporating this limitation of claim 1, the pending claims 47, 57 and 63 also could be literally infringed without literally infringing claims 7 and 12 of the '486 patent for at least the same reasons as claim 1 of the '486 patent. Therefore, the statutory double patenting rejection should be withdrawn.

Additionally, claim 1 of the '486 patent recites, "a recommendation generator coupled to the score generator for: accessing a set of analysis rules, with a plurality of the rules being subject specific...." In contrast claims 47, 57 and 63 recite retrieving "at least two rules from a group of rules" and "with at least one of the rules being about the subject...." Thus, the pending claims 47, 57 and 63 of the application could be literally infringed without literally infringing claim 1 of the '486 patent, because claim 1 of the '486 patent includes the limitations of "a plurality of the rules being subject specific". With claims 7 and 12 of the '486 patent incorporating this limitation of claim 1, the pending claims 47, 57 and 63 again could be literally infringed without literally infringing claims 7 and 12 of the '486 patent for at least the same reasons with respect to

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claim 1 of the '486 patent.

For at least the reasons stated above, Applicants submit that the statutory double patenting rejection should be withdrawn.

Rejections Under 35 U.S.C. § 112, 1st paragraph

Claims 47, 57 and 68 have been rejected under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the written description requirement. Specifically, the Office action states the language of "resolving the conflict by generating another rule" is not supported by the specification and is considered new matter. Applicants respectfully disagree. However, to expedite prosecution, the claims have been amended to recite, "resolving the conflict by generating a new rule." Accordingly, the rejection to the claims should be withdrawn.

Rejections Under 35 U.S.C § 102(e)

Claims 47-51, 53-54, 56-58, 60, 62-64, 66 and 68 were rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent No. 5,904,485 to Siefert. This rejection is respectfully traversed.

In making the rejection, the Office action cites to Table 4.2 of Siefert for teaching "retrieving, from a storage device, at least two rules from a group of rules, with at least one of the rules being about the subject...." Office action, at page 6. Applicants submit that Table 4.2, which is entitled, "A Summary of External Conditions Which Can Critically Influence the Process of Learning" does not teach or suggest retrieving, from a storage device, at least two rules from a group of rules, with at least one of the rules being about the subject. As its title indicates, Table 4.2 is a summary of external conditions which can influence the process of learning. Table 4.2 fails to teach or suggest, for example, that the summary of external conditions includes rules retrieved from a storage device.

Further, the Office action cites to Siefert, col.15, line 52 to col. 16, line 20, for teaching "determining, based on the at least two rules, the additional materials to present to the user, after the materials accessed by the user at (a)

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have been presented to the user." Office action, at page 7. This cited section of Siefert pertains to a student scoring below average being given a diagnostic check in the form of a question. The diagnostic results are processed, with the curriculum adjusted. If a student requests "other" he or she will be connected with a teacher for a live conference. If the student chooses to either change subjects or log off, the computer will place him at the beginning of remediation for the next time the unit is requested. If the student chooses further study, he will begin the remediation for the unit. When the student completes the remediation, the score is displayed. If the student still scores below average the student should be connected with a teacher.

As described above, Table 4.2 fails to teach the feature of "retrieving, from a storage device, at least two rules from a group of rules with at least one of the rules being about the subject...," as recited in claims 47, 57 and 63. Assuming for the sake of argument that Table 4.2 does teach this feature, it still fails to show determining based on the at least two rules the additional materials to present to the user. Table 4.2 fails to indicate additional materials to present to the user after he has obtained a testing score, namely a below average score as described in the above cited section of Siefert. Table 4.2 provides a summary of external conditions which can influence the process of learning but it does not indicate that the external conditions must be used or in what manner they should be used.

Additionally, the Office action cites to Siefert, col. 7, line 28 to col. 8, line 62, for teaching "wherein (c) includes determining, by a computing device, whether the at least two rules have a conflict in view of an assessment of the user, and, if there is a conflict, resolving the conflict by generating another rule that is added to the group of rules to help determine the additional materials to present to the user, the computing device being coupled to the storage device, and wherein the at least two rules have a conflict in view of an assessment when a consequence of at least two rules differs from the assessment...." Office action, at page 7. This cited section of Siefert pertains to information contained in the learning profile such as student's curriculum or major, preferred teaching

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strategies, student's present standing and other personalized information. The learning profiles facilitate an Intelligent Administrator to match student's needs with resources.

As described above, Table 4.2 fails to teach retrieving, from a storage device, at least two rules from a group of rules with at least one of the rules being about the subject. Assuming for the sake of argument that Table 4.2 does teach this feature, it still fails to show determining "whether the at least two rules have a conflict in view of an assessment of a user, and, if there is a conflict, resolving the conflict by generating another rule that is added to the group of rules to help determine the additional materials to present to the user in spite of the at least two rules having a conflict in view of an assessment of a user...," as recited in claims 47, 57 and 63. It is not clear how Siefert's learning profiles in the above cited section could be applied to the rejected limitations. But no matter how the cited sections are applied, Table 4.2 still does not provide that at least two rules having a conflict in view of an assessment. Further, even if there was a conflict, there is no teaching or suggestion of generating another rule that is added to Table 4.2 (or the group of rules as appears to be indicated by the Office action) to resolve the conflict.

In responding to Applicants' arguments of the Amendment dated October 12, 2010, the Office action states:

> The Examiner points to Table 4.2, where Siefert discloses a complex set of rules with hierarchy similar to the present invention, but without calling it a conflict. When a set of rules come into a "conflict" that is the logic path has reached a level stage, the next weighted constraint has priority to decide the next step. If a previously set hierarchy is set properly, all logic decision will yield a result, or the system will halt. It is the examiner's view that the "conflict depicted by the applicant is a decision making step with a secondary branch if the first logic branch reaches an "equal" value step. Office action, at page 3.

In response, Applicants submit that Siefert fails to teach or suggest that Table 4.2 is a complex set of rules with hierarchy. (Note also that Applicants' invention is not limited to a complex set of rules with hierarchy.) Siefert does not disclose that the external conditions in Table 4.2 include a complex

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hierarchy. The Office action indicates that if such a hierarchy is set properly, all logic decision will yield a result or the system will halt. This is not taught or suggested in Siefert for at least the reason that such a hierarchy is not shown in Table 4.2.

Therefore Applicants submit that independent claims 47, 57 and 63 are novel and non-obvious over Siefert. As claims 48-56, 58-62, and 64-68 depend from claims 47, 57 and 63, respectively, the rejection to these claims should be withdrawn for at least the same reasons as their respective independent claims.

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Conclusion

For at least the reasons submitted above, Applicants submit that the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

It is believed that no fees are due in connection with the filing of this Amendment. However, if it is determined that any fees are due, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-0727 (order no. 170 Cont2).

Respectfully submitted,
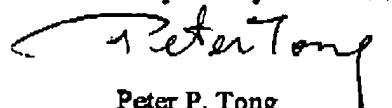
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